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JGJR: 03-04

Paper No: 10

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MAR 12 2004

OFFICE OF PETITIONS

In re Application of

O'Connor

Application No. 10/057,622

Filed: 25 October, 2001

Attorney Docket No. 3135-22

ON PETITION

This is a decision on the petition filed on 25 February, 2004, to revive the above-identified application under 37 C.F.R. §1.137(b)

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

NOTE:

The address of record in this matter and the address listed with the Office of Enrollment and Discipline (OED) are different from that submitted on Petitioner's papers. If Petitioner desires to receive future correspondence regarding this application, the appropriate change of address and/or power of attorney documentation must be submitted.

A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Non-Compliant Amendment mailed on 28 May, 2003, with a reply due (absent a request and fee for extension of time) on or before Monday, 30 June, 2003;
- as a result, the application was deemed abandoned after midnight 28 June, 2003;
- no Notice of Abandonment was mailed before the original petition was filed;
- the original petition alleging unavoidable delay 37 C.F.R. §1.137(a) (accompanied by the reply) and accompanying declaration recite alleged delay by the Office in forwarding to Petitioner in February 2002 the filing receipt (for the 25 October, 2001, filing date) as the instigation of Petitioner's unavoidable delay, and--according to the allegations of the petition and accompanying declaration--the four month period between the filing of the application and delivery to Petitioner of the filing receipt caused Petitioner's staff to submit papers twice with the wrong application number--which error the Petitioner and Declarant acknowledge the Examiner ignored and nonetheless addressed the filings in the instant (and proper) application;
- however, it was Petitioner's failure to reply timely and properly to the 28 May, 2003, Notice that triggered the abandonment, and despite Declarant's statement otherwise, there is no documentary evidence that reply was mailed until shipment of the USPS Express Mail package bearing Label No. EU802507199US on 31 October, 2003, by which the instant petition also was transmitted, and therefore the original petition was dismissed on 29 January, 2004, for failing to satisfy the "showing" requirement under 37 C.F.R. §1.137(a);
- with the request for reconsideration, Petitioner submitted an Express Mail receipt bearing Label No. EU058467763US, but no document of record also bears that number, and so the petition was dismissed on 11 March, 2004;
- with the instant petition, Petitioner paid the fee and made the statement of unintentional delay--the reply requirement having previously been satisfied.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.² Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴

And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶))

Petitioner has satisfied the regulatory requirements.

Accordingly, in view of the record, the petition as considered under 37 C.F.R. §1.137(b) hereby is granted.

¹ 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁴ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared and/or deposited for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely prepared and/or deposited for shipment.

The instant application is forwarded to Technology Center 3700 for further processing.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read 'J. Gillon', with a stylized flourish at the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

cc:

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